

No. 22083

**United States Court of Appeals
For the Ninth Circuit**

YOUNG CORPORATION a Washington corporation,
Plaintiff-Appellant,

vs.

ROY F. JENKINS, and JANE DOE JENKINS,
his wife, dba DOROT GRAPPLY COMPANY,
Defendants-Appellees.

APPEAL FROM UNITED STATES DISTRICT COURT
DISTRICT OF OREGON

APPELLANT'S OPENING BRIEF

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INDEX

	<i>Page</i>
Jurisdiction	1
Statement of the Case	1
A. The Nature of the Controversy	1
B. The Parties	2
C. The Pleadings	2
D. The Invention of the Lindberg Patent No. 3,082,031 on Appeal	3
E. Disposition of the Case by the Court	5
F. The Questions Presented for Determination ..	6
Specification of Errors	6
Summary of Plaintiff-Appellant's Arguments	9
A. Infringement	9
B. Validity	9
Infringement	10
A. Every Structural Element of the Combination Recited in Claim 1 of the Lindberg Patent No. 3,082,031 and its Function is Presented in the Jenkins Two Point Log Grapple	10
B. The File History of the Lindberg Patent and the File of Interference No. 91393 Between the Parties Indicate that Appellees Have, on Two Occasions, Adopted the Language of Claim 1 of the Lindberg Patent to Describe the Jenkins Grapple Structure and Have Acknowledged that the Phrase "Pivot means pivotally interconnecting said jaws" Is Intended to and Does Read on Any Pivot Means Interconnecting the Upper Ends of the Jaws	18
C. Testimony of Lindberg and Jenkins	21

INDEX

	<i>Page</i>
D. The Doctrine of Equivalents Cannot be Used in Reverse to Limit Claim 1 in View of the Clear Showing in the File History That Both Parties to the Suit Intended the Claim Language to Encompass the Accused Grapple Structure	22
Validity	23
A. Novelty — Prior Art, Scope and Content	23
B. Utility	27
C. Nonobviousness — The Lindberg Invention Was Not Obvious to One Having Ordinary Skill in the Grapple Art At the Time of the Invention	28
D. Defendants-Appellees Have Failed to Overcome the Presumption of Validity that Attaches to the Lindberg Patent and to Support the Burden of Proving Invalidity	42
Appendix	45

TABLE OF CASES

<i>Abington Textile Works v. Card Specialists Ltd.</i> , 148 U.S.P.Q. 33 (D.C. Dist. of Col. 1965)	25
<i>Dresser Industries, Inc. v. Smith-Blair Inc.</i> , 9 Cir. 1963, 322F.2d 878	26
<i>Graham et al v. John Deere Co. of Kansas City et al</i> , 383 U.S. 1, 12, 148 U.S.P.Q. 459	28
<i>Hensley Equipment Co., Inc. v. Esco Corp.</i> , 9 Cir., 375 F.2d 432, 152 U.S.P.Q. 781	29
<i>Jeddeloh Brothers Sweed Mills, Inc. v. Coe Manufacturing Co.</i> , 9 Cir., 306 F.2d 455, 151 U.S.P.Q. 679	29
<i>Moon v. Cabot Shops</i> , 270 F.2d 539, 123 U.S.P.Q. 60, 63 (CA9-1959)	18

TABLE OF CASES

	<i>Page</i>
<i>National Lead Co. v. Western Lead Products Co.</i> , 9th Cir. 291 F.2d 447	28
<i>National Sponge Cushion Co. v. Rubber Corp.</i> , 286 F.2d 731, 735, 128 U.S.P.Q. 320, (CA9-1961)	24
<i>United States v. Adams et al</i> , 383 U.S. 39, 148 U.S.P.Q. 459	28

UNITED STATES STATUTES

28 U.S.C. 1291	1
28 U.S.C. 1338	1
28 U.S.C. 2201	1
35 U.S.C. 101	9, 28, 45
35 U.S.C. 102 (a) and (b)	9, 28, 45
35 U.S.C. 103	9, 28, 42, 45

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APPELLANT'S OPENING BRIEF

JURISDICTION

This is an appeal from the judgment of the District Court in an action for Patent Infringement based on 28 U.S.C. Section 1338 (Complaint R-1) and a counterclaim for declaratory judgment (Defendant's Answer R-9) based on 28 U.S.C. Section 2201. There is no issue of jurisdiction, the parties having agreed that the Court has jurisdiction of the parties and the subject matter of the suit (AGREED FACTS — Pre-Trial Order R-18). Title 28 U.S.C. Section 1291 gives this Court jurisdiction of this appeal.

STATEMENT OF THE CASE

A. The Nature of the Controversy

The suit in the District Court was for infringement

of United States Letters Patent, No. 3,082,031, for Two Point Log Grapple (Complaint R-1). A counterclaim for declaratory judgment of invalidity and non-infringement and for relief from business harassment and award of attorney fees and costs was filed by Defendants (Defendants' answer R-9). This appeal relates only to the claim and counterclaim as respects validity and infringement of the patent, and no appeal is taken from the decision of the District Court relating to the portion of the counterclaim dealing with Defendants' claim of business harassment and attorney fees and costs.

B. The Parties

Plaintiff-Appellant, Young Corporation, is a Washington corporation, and has its principal place of business in Seattle, Washington. United States Letters Patent No. 3,082,031, was granted March 19, 1963, to Isaacson Iron Works, assignee of Robert H. Lindberg and was subsequently assigned to Plaintiff Young Corporation.

Defendants, Roy F. Jenkins and Dora (Jane Doe) Jenkins, his wife, are doing business under the assumed name Doroy Grapple Company and are residents of Lebanon, County of Linn, Oregon. Defendants have since the date of issue of the patent, and since receiving notice of said patent sold two point log grapples accurately disclosed in Plaintiff's Exhibit 5, pages 9 and 30 and Figs. 1-3 of Patent No. 3,102,752, page 17 of this Brief, (AGREED FACTS, 10 and 13 — Pre-Trial Order R-18).

C. The Pleadings

The Complaint was filed by Plaintiff, Young Cor-

poration, against Defendants Roy F. Jenkins, and Jane Doe Jenkins, his wife, dba Doroy Grapple Company, on June 30, 1964, and Defendants filed their Answer on August 27, 1964. With their Answer Defendants filed a Counterclaim for a declaratory judgment. Plaintiff filed its Reply to Affirmative Defense and Counterclaim on September 8, 1964. A Pre-Trial Order, approved by the parties and District Court, was lodged August 23, 1965.

D. The Invention of the Lindberg Patent No. 3,082,031 on Appeal

The invention relates to improvements in devices known as grapples and to devices that belong to the general character of grapples and in particular to grapples used with log loaders known as "heel boom loaders." With this type of loader a log is picked up short of its mid-point by the grapple which is suspended by cables from a boom and the short end of the log is forced against a heeling plate on the bottom of the boom. The log is heeled or pivoted to a desired position and deposited on a truck, railroad car or the like. The grapple which is the subject matter of the patent is characterized as being a two point, scissors type log grapple. The grapple has a horizontal cross-beam and downwardly extending links or legs are secured to opposite ends of the cross-beam.

The jaws are substantially alike and are arcuately shaped. The jaws are pivotably joined to the legs intermediate the ends of the jaws. The lower ends of the jaws engage the logs to be lifted and the upper ends of the jaws constitute lever arms for operating the jaws. The lever arms or upper ends of the arcuate

jaws are pivotally interconnected by a pivot means and one of the lever arms is provided with a pulley or sheave wheel at its upper end.

Two control cables are used in operating the grapple. One of the cables is a lifting cable attached to the cross beam and the other cable is a jaw controlling cable. The jaw controlling cable passes between a double set of guide rollers on the cross-beam and about the sheave wheel on the one jaw then upwardly about a second sheave wheel on the cross beam and downwardly where it dead heads on the upper end of the other jaw. When the grapple is free from a log, it is raised and lowered by the lifting cable. When the grapple is in engagement with a log, the controlling cable causes the jaws to squeeze or clamp the log by hauling in on the jaw controlling cable. The controlling cable also provides the lifting force to raise the log. The jaws are permitted to open by gravity under their own weight by releasing the controlling cable.

Claim 1 of the patent is a combination claim which recites the following elements and the inter-relationship and functional relationship between these elements.

1. A pair of cables
2. A frame structure
3. A pair of legs
4. Two jaws
5. Means to secure one cable to the frame structure
6. Means pivotally securing the legs to the frame and jaws
7. Pivot means interconnecting the pair of jaws
8. The other cable is interconnected to the jaws

The advantages of the patented two point grapple include:

(1) The log loading operation is accomplished by a single operator.

(2) A log can pivot freely between jaws.

(3) Since a log is allowed to freely pivot, the grapple structure maintains its alignments with the load line (controlling cable) eliminating or reducing bending strains in the grapple jaws and legs.

(4) Damage to the log surface of a log is prevented since the log freely pivots between the two gripping jaws.

(5) The two jaw grapple is substantially narrower in width and thus more readily maneuverable than conventional and previously used three or four point grapples when picking up logs from a tangled deck of logs.

E. Disposition of the Case by the Court

At the conclusion of a trial on the merits, beginning February 10, 1966, heard without a jury, the District Court requested that both parties file additional briefs and entered an order on February 11, 1966, taking the case under advisement. The briefs were duly filed and an Opinion was not entered by the District Court until April 12, 1967, along with an order that Defendants prepare Findings of Fact, Conclusions of Law and a Judgment in their favor consistent with the Opinion (R-37). On April 19, 1967, Defendants submitted proposed Findings of Fact and Conclusions of Law to the District Court. The District Court made

extensive revisions to the Findings of Fact and on April 25, 1967, the revised Findings of Fact, Conclusions of Law and Judgment in favor of Defendants were filed, entered and signed by the District Court.

F. The Questions Presented for Determination

This appeal raises the following questions for appeal:

(1) Does the Jenkins' grapple shown in Plaintiff's Exhibit 5, pages 9 and 30 and Figs. 1-3 of Patent No. 3,102,752 infringe claim 1 of the Lindberg Patent No. 3,082,031, Plaintiff's Exhibit 1?

(2) Are claim 1, 2 and 3 of the Lindberg Patent No. 3,082,031 valid?

SPECIFICATIONS OF ERRORS

Plaintiff-Appellant contends that the District Court erred in the following respects:

1. In dismissing the Complaint.
2. In holding all claims of Lindberg Patent No. 3,082,031 invalid.
3. In holding that claim 1 of the Lindberg Patent No. 3,082,031 is not infringed by Defendants-Appellees.
4. In concluding that Lindberg agreed that claim 15 of the Lindberg application was not patentable to Lindberg.
5. In concluding that claim 19 of the Lindberg application was rejected on prior art references.

6. In concluding that Plaintiff-Appellant contends that the Lindberg Patent covers all two point grapples.

7. In concluding that Plaintiff-Appellant relies on the doctrine of equivalents to find infringement by Defendant-Appellees of the Lindberg Patent in suit.

8. In comparing a tong structure with a grapple.

9. In concluding that a two point grapple and three and four point grapples are practically identical in construction and mode of operation.

10. In holding that it does not constitute patentable invention to change the structure of the Italian Patent to Giovanetti No. 488,553 from a three point grapple into a two point grapple.

11. In holding that based upon the United States Patent to Hunt No. 512,825 it is obvious to one of ordinary skill in the art, to construct a grapple as recited in claim 1 of the Lindberg Patent.

12. In holding that the only difference in operation between a three point grapple and a two point grapple is one of degree.

13. In holding that the file history of the Lindberg Patent application in the Patent Office shows that the Patent Examiner did not consider a two point grapple to be patentable, and the only way in which Lindberg obtained allowance of claims was to limit them to the constructional details of his particular grapple.

14. In holding that Lindberg did not disregard principals of mechanics in inventing and designing his two point grapple.

15. In holding that the elements recited in claim 1 of the Lindberg Patent are all old and function together in the expected manner to produce the expected result.

16. In holding that at the time that Lindberg made the invention which was the basis for the patent in suit, there was nothing unobvious about his invention to a person having ordinary skill in the grapple art and therefore did not meet the requirements of 35 U.S.C. 103. (Appendix)

17. In holding that the invention covered by the Lindberg Patent is a minor one and the patent is not entitled to any breadth of interpretation.

18. In holding that based upon the file history of the Lindberg Patent claim 1 of the Lindberg Patent is limited to a grapple structure wherein the jaws overlap at their upper ends and are held together by a common pivot pin.

19. In holding that based upon the file history of the Lindberg Patent, claim 1 of the Lindberg Patent is limited to a grapple construction wherein a pulley is mounted on one end of the jaws and around which a controlling cable is reeved.

20. In failing to hold the Lindberg Patent valid based upon the evidence and facts presented during trial and as part of the record on appeal.

21. In failing to hold the Lindberg Patent is infringed by Defendants-Appellees based upon the facts and evidence presented during trial and as part of the Record on Appeal.

SUMMARY OF PLAINTIFF-APPELLANT'S ARGUMENTS

A. Infringement

1. Defendants-Appellees infringe claim 1 of the Lindberg Patent as demonstrated by the Trial testimony of Lindberg and the testimony of Jenkins in his deposition.

2. Defendants-Appellees admitted infringement of claim 1 of the Lindberg Patent by copying substantially identical claims in the Jenkins patent application during the Interference proceeding in the Patent Office. Defendants-Appellees argued to the Patent Office that the language of the claim was broad enough to read on any pivot means interconnecting the upper ends of the jaws.

3. There is nothing in the file history of the Lindberg patent application that requires that the doctrine of equivalents be used in reverse to limit the language of claim 1. The clear showing from the file history is that both parties to this suit intended the claim language to encompass the accused grapple structure sold by Defendants-Appellees.

B. Validity

1. Claim of the Lindberg Patent meets the statutory requirements or validity set forth in 35 U.S.C. 101, 102 and 103. Appendix. The utility of the patented structure has been admitted. There is no evidence to refute the conclusion of novelty. The only prior art patent relied upon by Defendants-Appellees is the Hunt Patent. All of the other prior art patents on grapples teach grapples with three or more jaws.

2. All of the evidence and testimony in the record substantiates that the grapple structure covered by claim 1 of the patent was not obvious to one skilled in the art at the time the Lindberg invention was made. Lindberg testified that experts in the art expressed doubt and disbelief in the two point grapple concept when it was first proposed by Lindberg, hence it was not obvious to the experts. Jenkins is skilled in the art and he urged the Patent Office that the broad concept of his two point grapple was novel and patentable. Further the patented invention was not obvious to several Examiners in the Patent Office who were knowledgeable and skilled in the prior art.

3. The Lindberg invention achieved immediate and substantial commercial success and acceptance.

INFRINGEMENT

A. EVERY STRUCTURAL ELEMENT OF THE COMBINATION RECITED IN CLAIM 1 OF THE LINDBERG PATENT NO. 3,082,031, AND ITS FUNCTION IS PRESENT IN THE JENKINS TWO POINT LOG GRAPPLE

The drawing of Appellee Jenkins' Patent No. 3,102,752 which issued from patent application Ser. No. 124,190, filed July 14, 1961 is reproduced on page 17 of this Brief. The parties have agreed that the accused two point grapple structure is truly and accurately disclosed on pages 9 and 30 (patent drawings) of the Jenkins patent application Ser. No. 124,190 (AGREED FACTS, 10 and 13 — Pre-Trial Order R-18). Claim 1 of the Lindberg Patent is read on the Lindberg and Jenkins' log grapple structures respectively as follows, with reference being made to the drawings of the Lindberg and Jenkins patent drawings, pages 14-16 and 17 respectively of this Brief.

Claim 1

Lindberg

Jenkins

A two point, scissors type log grapple wherein the jaws are pivotally mounted to open by gravity and wherein the grapple is operative for its intended purpose in any position of the jaws from fully open to fully closed; a pair of cables to lift and control the operation of said grapple,

32, 35

cable in
broken line
and cable 14

one of said cables being a lifting cable

32

cable in
broken line
connected to
clevis on
crosshead 10

and another of said cables being a controlling cable,

35

14

said grapple comprising a frame structure,

10, 11, 13

10, 16, 18

means interconnecting one of said cables to said frame structure,

33, 34

clevis on
crosshead 10

said frame structure including a pair of legs

11, 13

16, 18

with a least one of said legs being pivotally connected thereto,

13

16 or 18

said log grapple consisting of only two jaws having upper and lower end portions,

15, 15'

20, 22

said jaws having oppositely facing arcuate log engaging surfaces formed thereon at their lower ends,

arcuate surfaces of 15 and 15' arcuate surfaces of 28 and 30

pivot means pivotally interconnecting said jaws above said log engaging surfaces,

16 32 and pivot bolts no numbers

one of said jaws being pivotally connected between said pivotal interconnection and the lower end thereof to the lower end of one of said legs

15 or 15' 20 or 22

and the other of said jaws being pivotally connected between said pivotal interconnection and the lower end thereof to the lower end of the other of said legs,

15 or 15' 20 or 22

the lower end portion of said jaws being in substantial overlapping relationship when the jaws are in fully closed position,

Fig. 6 Fig. 1

said jaws being pivotally connected to the associated legs at points disposed below the pivotal interconnection of the jaws when the jaws are in overlapping position,

Fig. 6 Fig. 1

said jaws including side surfaces at the lower end portions thereof disposed adjacent to the lower por-

tions of said log engaging surfaces,

side
surfaces of
15 and 15'

side
surfaces of
28 and 30

said side surfaces being disposed adjacent to one another when the jaws are in overlapping relationship,

Fig 6

Figs. 1
and 2

all of said lower end portion of one of said jaws lying on one side of a plane lying between said side surfaces when the jaws are in overlapping relationship and all of said lower end portion of the other of said jaws lying on the other side of said plane,

Fig 6

Figs. 1
and 2

the other of said cables being interconnected to at least one of said jaws whereby the paying out of said other cable permits the jaws to open by gravity and whereby the winding in of said other cable causes the jaws to close and apply squeezing pressure against a log therebetween.

35, 38

14, 62

March 19, 1963

R. H. LINDBERG

3,082,031

TWO POINT LOG GRAPPLE

Filed Aug. 25, 1958

3 Sheets-Sheet 1

Fig. 1

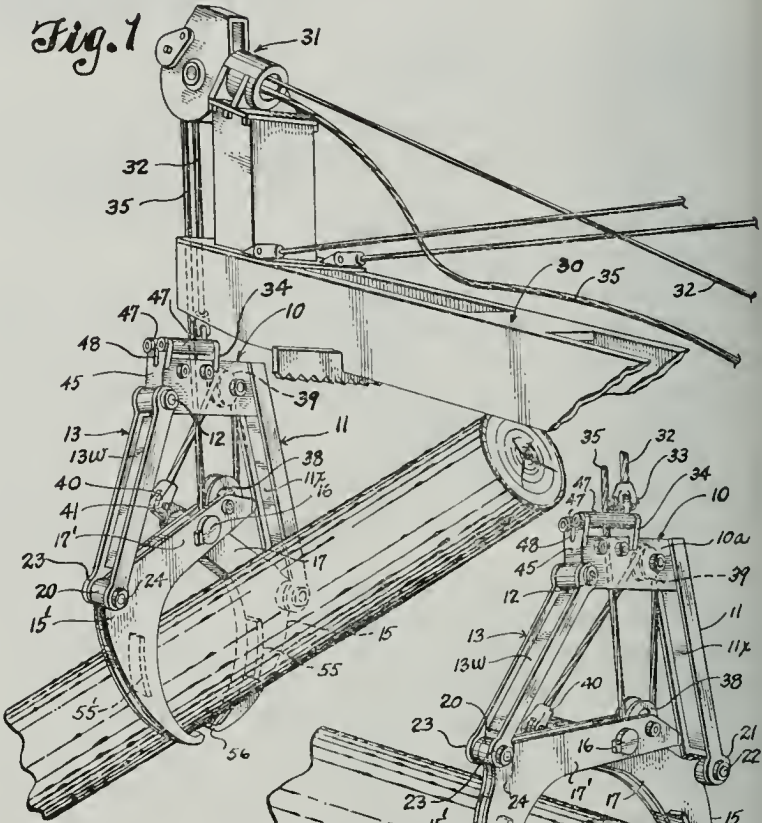
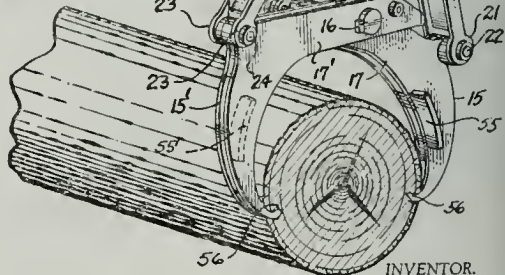


Fig. 2



INVENTOR.

ROBERT H. LINDBERG

BY
Robinson & Derry
ATTORNEYS

March 19, 1963

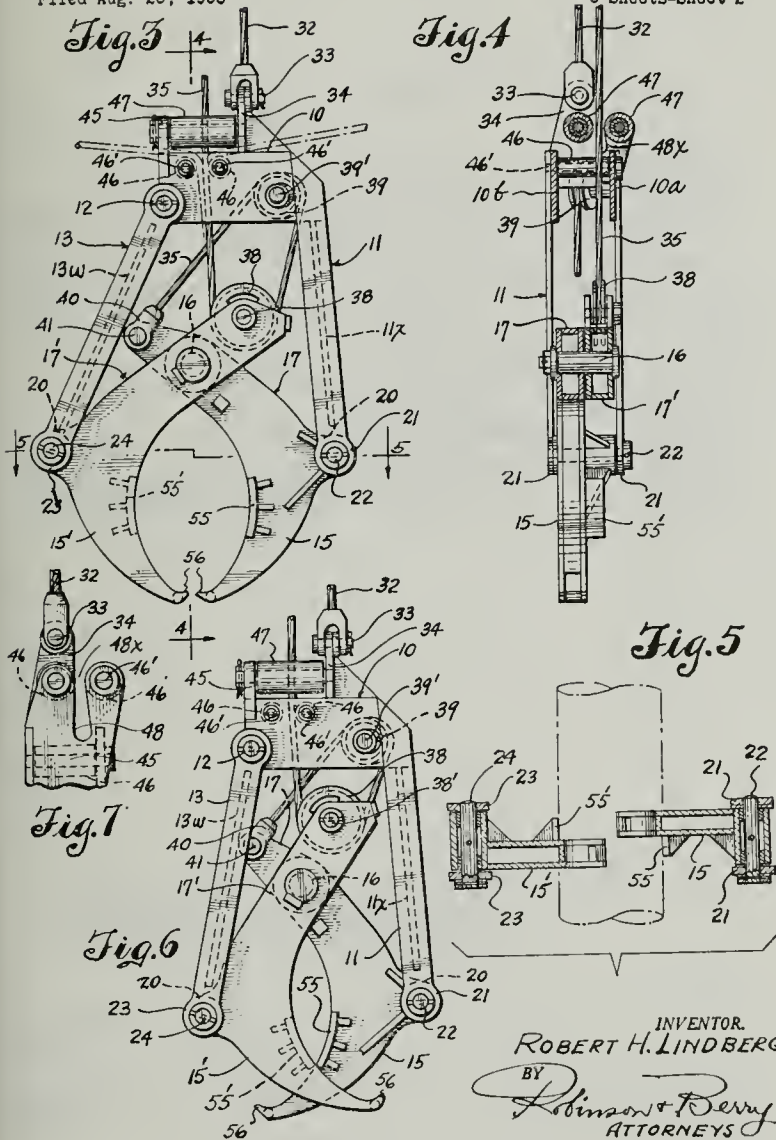
R. H. LINDBERG

3,082,031

TWO POINT LOG GRAPPLE

Filed Aug. 25, 1958

3 Sheets-Sheet 2



INVENTOR.
 ROBERT H. LINDBERG
 BY *Robinson & Berry*
 ATTORNEYS

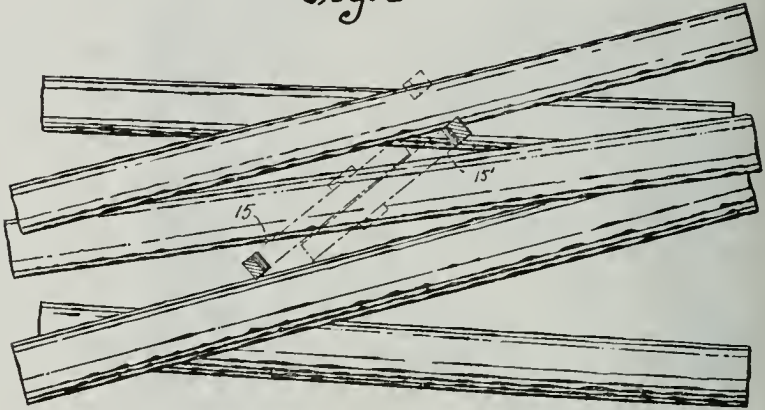
March 19, 1963

R. H. LINDBERG
TWO POINT LOG GRAPPLE

3,082,031

Filed Aug. 25, 1959

3 Sheets-Sheet 3

Fig. 8

INVENTOR.
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Robinson + Berry
ATTORNEYS

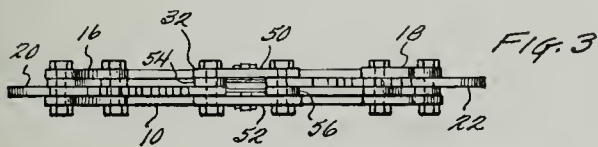
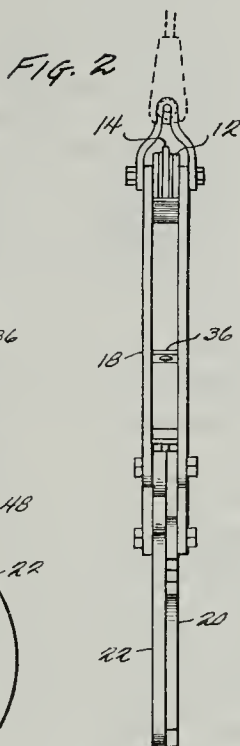
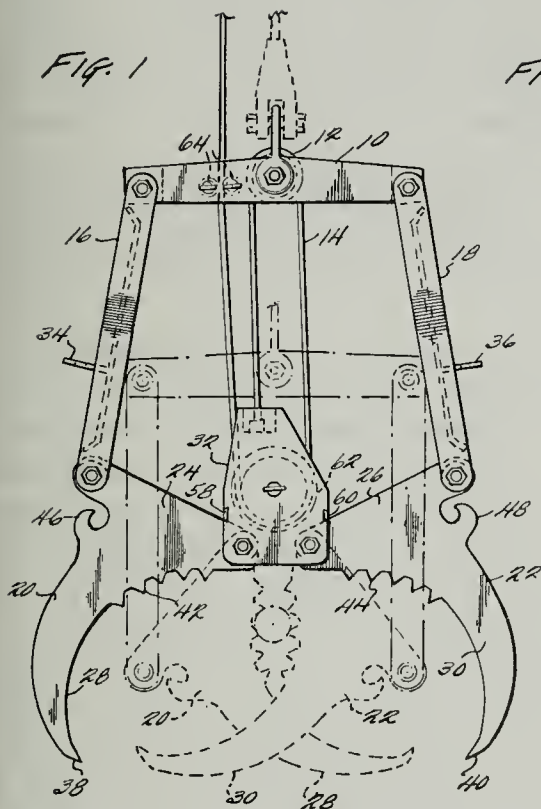
Sept. 3, 1963

R. F. JENKINS

3,102,752

LOG GRAPPLE

Filed July 14, 1961



INVENTOR

ROY F. JENKINS

BY

Kimmel & Powell
ATTORNEYS

B. THE FILE HISTORY OF THE LINDBERG PATENT AND THE FILE OF INTERFERENCE NO. 91393 BETWEEN THE PARTIES INDICATE THAT APPELLEES HAVE ON TWO OCCASIONS, ADOPTED THE LANGUAGE OF CLAIM 1 OF THE LINDBERG PATENT TO DESCRIBE THE JENKINS GRAPPLE STRUCTURE AND HAVE ACKNOWLEDGED THAT THE PHRASE "Pivot means pivotally interconnecting said jaws" IS INTENDED TO AND DOES READ ON ANY PIVOT MEANS INTERCONNECTING THE UPPER ENDS OF THE JAWS

The District Court concluded (Finding of Fact No. 21, R-44) that the accused grapple does not infringe claim 1 of the Lindberg Patent because it calls for "pivot means pivotally interconnecting said jaws above said log engaging surfaces", and for the controlling cable to be "interconnected to at least one of said jaws". The basis for this conclusion is said to be the "teachings and history of the Lindberg Patent", quoting from FINDINGS OF FACT NO. 21 (R-44). Although the Court is correct in relying upon the file history of the patent to interpret the claim language, *Moon v. Cabot Shops, Inc.*, 270 F.2d 539, 123 USPQ 60, 63 (CA9-1959), the Court erred in reaching its conclusion since the history of the Lindberg Patent clearly indicates that Appellant and Appellees, as well as the Patent Office, considered the quoted language as describing the Jenkins grapple.

The quoted language from claim 1 covering the two features referred to by the District Court in Finding No. 21 is the exact language adopted by Defendant-Jenkins to describe these two features during Interference No. 91393 (Plaintiff Exhibit No. 6) between Appellant's patent application Ser. No. 756,866 (Plaintiff's Exhibit 2) which matured into the patent

in suit, and the Jenkins patent application Ser. No. 845,216, (Plaintiff's Exhibit 4) which disclosed a log grapple substantially identical in structure to that shown in Jenkins Patent No. 3,102,752. Claims 6 and 7 (pages 13 and 14 and 17 and 18, Plaintiff's Exhibit 4) of the Jenkins application Ser. No. 845,216 correspond to original Count 1 and proposed Count B respectively of the Interference between the Lindberg and the Jenkins patent applications. The following is a copy of claim 1 of the Lindberg Patent (claim 24 of the Lindberg application) with the *italicized* language being that which was added to claim 19 of the Lindberg application (Count B of the Interference) and the language in parenthesis being the language deleted from claim 19.

1. A two point, scissors-type log grapple wherein the jaws are pivotally mounted to open by gravity and wherein the grapple is operative for its intended purpose in any position of the jaws from fully open to fully closed; a pair of cables to lift and control the operation of said grapple, one of said cables being a lifting cable and another of said cables being a controlling cable, said grapple comprising a frame structure, *means interconnecting one of said cables to said frame structure*, (said structure including a horizontally disposed cross-head to which the free end of one of said cables is secured,) *said frame structure including* a pair of legs (secured to said cross-head and extending downwardly therefrom,) with at least one of said legs being *pivotally connected thereto*, (secured to said cross-head by a pivotal connection,) said log grapple consisting of only two jaws having upper and lower end portions, said jaws having oppositely facing arcuate log engaging surfaces formed thereon at their lower ends, pivot means pivotally interconnecting (the upper ends of) said jaws *above said leg engaging surfaces*, one of said jaws being

pivotally connected between said pivotal interconnection and the lower end of one of said legs and the other of said jaws being pivotally connected between said pivotal interconnection and (thereof to the lower end of) the other of said legs, the lower end portions of said jaws being in substantial overlapping relationship when the jaws are in fully closed position, said jaws being pivotally connected to the associated legs at points disposed below the pivotal interconnection (between) of the jaws when the jaws are in overlapping position, said jaws including side surfaces at the lower end portions thereof disposed adjacent to the lower portions of said log engaging surfaces, said side surfaces being disposed adjacent to one another when the jaws are in overlapping relationship, all of said lower end portion of one of said jaws lying on one side of a plane lying between said side surfaces when the jaws are in overlapping relationship and all of said lower end portion of the other of said jaws lying on the other side of said plane, the other of said cables being enterconnected to at least one of said jaws to open by gravity and whereby the winding in of said other cable causes the jaws to close and apply squeezing pressure against a log therebetween.

Appellees have thus twice adopted the position that the precise language used in claim 1 does in fact describe the Jenkins grapple structure which is now accused of infringement. The record shows that the United States Patent Office considered the counts of the Interference as being readable on both the Lindberg structure and the Jenkins structure.

In a paper entitled "Concurrence In Supplemental Decision and Motions" (item 3, page 59 of the Interference File — Plaintiff's Exhibit No. 6), filed during the Interference proceedings, Appellee Jenkins expressly opposed the broadening of the language in

Count B to call for "pivot means pivotally interconnecting said jaws" rather than "pivotally interconnected to one another" as recited in original Count 1. The argument made was that the language was broad enough to read on any pivot means interconnecting the upper ends of the jaws. Appellant in redrafting the claim language of Count B indeed intended to broaden the language so as to cover any means pivotally interconnecting the jaws. Appellee used the language and acknowledged its breadth and likewise the Patent Office considered the language as reading on both the Lindberg and Jenkins structures. The proper interpretation from the history of the Lindberg Patent can only be that all parties concerned intended the language to describe the Jenkins grapple.

The District Court held, however, that the language, when construed in light of the teachings and history of the Lindberg Patent, requires that the jaws be overlapped at one end and pivotally held to each other by a common pin. The District Court has erred in reaching this conclusion since it is not supported by the evidence. The Court correctly ruled during trial (Transcript of Proceedings, page 72, lines 19-23) that the statements made during the Interference by the party Jenkins are admissible as admissions.

C. TESTIMONY OF LINDBERG AND JENKINS

Referring to the Jenkins grapple, Figs 1 and 2 of the Jenkins Patent No. 3,102,752, page 17 of this Brief, it will be noted that the jaws 20 and 22 do in fact overlap and from a functional standpoint it is immaterial whether the jaws are pivoted on a common pivot or on two separate pivots since the function is the same. At trial, the witness Lindberg testified

(Transcript of Proceedings, page 32, line 2 through page 35, line 25) that each and every element recited in the claims is present in the accused structure and that the elements are in the same relationship and perform the same functions as the corresponding elements illustrated and described in the Lindberg Patent. There was no testimony, either direct or on cross-examination, to refute the conclusion of infringement.

Appellee Jenkins has given testimony that the Jenkins grapple includes every element recited in claim 1 including the two features referred to in FINDING OF FACTS NO. 21, (R-44) and held by the Court as distinguishing the two structures. Jenkins testified that the jaws of the accused grapple are pivotally interconnected by means of a block structure (Jenkins Dep. page 203-205 — Defendants' Exhibit No. 145). As to the controlling cable (closing line) Jenkins testified that it was so interconnected with the jaws that pulling on the closing line (controlling cable) causes the jaws to close (Jenkins Dep. page 203-205 — Defendants' Exhibit No. 145).

D. THE DOCTRINE OF EQUIVALENTS CANNOT BE USED IN REVERSE TO LIMIT CLAIM 1 IN VIEW OF THE CLEAR SHOWING IN THE FILE HISTORY THAT BOTH PARTIES TO THE SUIT INTENDED THE CLAIM LANGUAGE TO ENCOMPASS THE ACCUSED GRAPPLE STRUCTURE

The District Court finds that "the range of equivalents to which it (Lindberg Patent) would be entitled is so narrow that it would not encompass the accused grapple (FINDINGS OF FACT NO. 20, R-43-44). The Court is in error in this holding since the

Doctrine of Equivalents is not applicable to the present case.

Claim 1 reads directly on the Jenkins grapple and there is an identity of *means, operation* and *result* as established by the testimony of Jenkins and Lindberg. It is not necessary to place any interpretation on the language of claim 1 other than the plain meaning of the language and the interpretation placed thereon during prosecution of the Lindberg application before the Patent Office in order to encompass the accused grapple. Plaintiff is not relying, nor is it necessary to rely, on the Doctrine of Equivalents in order to broaden claim 1 to read on the accused device. As demonstrated supra, claim 1 reads directly, element-for-element, on the accused grapple without broadening or stretching the terms. Likewise there is no basis for limiting the claim so as to exclude the Jenkins structure since the file history indicates that all parties concerned (Lindberg, Jenkins and the the Patent Office) intended the claim to encompass the Jenkins grapple. There is nothing in the file history of the patent which would place further limitations on the language of claim 1.

VALIDITY

A. NOVELTY — PRIOR ART, SCOPE AND CONTENT

The District Court held (FINDINGS OF FACT No. 10, R-42) that the Examiner in the Patent Office correctly stated that it would not amount to patentable invention to change a three point grapple into a two point one. The Court erred in this conclusion since the patent Examiner did allow claim 24 of the Lindberg patent application which was claim 19 (Count B of the Lindberg-Jenkins Interference)

amended to slightly broaden its scope and to correct a typographical error.

The Italian Patent to Giovanette No. 488,533 (Defendants' Exhibit No. 123) as well as Plaintiff's own three and four point grapple structures were before the patent Examiner, (Plaintiff's Exhibit 2, pages 22-29) as representing the prior art.

Furthermore, the questions of anticipation and obviousness were considered at great length by the Patent Office during the prosecution of the Lindberg application and during the course of the Interference proceeding involving the Lindberg and Jenkins applications. The file history of the Lindberg application (Plaintiff's Exhibit No. 2, page 89) indicates that the Examiner made an extensive and thorough search of the prior art. Both the Lindberg application file history and the Interference file (Plaintiff's Exhibit No. 6) attest to the fact that the question of obviousness was considered at great length. Two Assistant Examiners and one Primary Examiner were involved in consideration of the Lindberg application. The Examiners had all manner of tongs, hooks, and grapples before them and, like Defendants, found no teaching of the concept or structure of a two jaw grapple with overlapping jaws as recited in claim 1. That the decision of the Patent Office Examiner should be given significant weight so as to strengthen the presumption of validity in the instant case is both logical and compelling. This logic is applied in the Ninth Circuit, see *National Sponge Cushion Co. v. Rubber Corp.*, 286 F.2d 731 at page 735.

The file wrapper of the Lindberg application also indicates that the Examiners were personally interviewed several times by the inventor Lindberg and

his attorney and the Examiners had full knowledge of the background of the art and operation of grapples. This was not a case of dealing at arms length or a mere academic approach to the question of invention. The personal interviews further substantiate the fact that the claims of the patent underwent a thorough prosecution and the patent was not lightly granted by the Patent Office. The presumption of validity is therefore strengthened and the Court should not lightly hold the patent invalid. See the recent decision in *Abington Textile Works v. Carding Specialists Ltd.*, 148 USPQ 33, (D.C. Dist. of Col — 1965) at page 47.

It was admitted by the attorney for Defendants-Appellees that the Hunt Patent (Defendants' Exhibit 103) is the best reference and that "all of these other patents were put in there for the purpose of showing how crowded the art is" (Transcript of Proceedings, page 107). With respect to the Hunt Patent, Lindberg testified (Transcript of Proceedings pages 112 and 113):

Q. (By Mr. Berry) Mr. Lindberg, do I understand your testimony as to 103, that in a side view, the grapple structure as illustrated in Hunt's would be similar to that illustrated in Harrington's, Defendants' Exhibit 111?

A. In that, it would show multiple teeth on each side — the Harrington's.

Q. Do they have any general terms they refer to a grapple of this type as?

A. There are a number of terms.

Q. In your opinion, assuming that D-103 has a plurality such as D-111, could such a device be used commercially for heel boom loading operations?

A. Not any more effectively than any multiple point device.

Q. Could the log freely pivot between the jaws?

A. No.

Q. Could the jaws grab a small log?

A. No.

There was no evidence or testimony to contradict the witness Lindberg's conclusion that Hunt does not show a two point grapple. Although "Even one prior art reference which has not be considered by the Patent Office may overthrow the presumption of validity", *Dresser Industries Inv. v. Smith-Blair Inc.* 9 Cir., 1963, 322 F.2d 878, a reading at column 2 on page 888 of the decision indicates that the reference must also be "pertinent". The Hunt Patent is no more pertinent than the Giovanetti Patent or Plaintiff's three and four point grapples which the Patent Examiner considered.

The District Court erred in its statement in the Opinion, page 2, paragraph 3, wherein it states "The interference was dissolved after both parties agreed that neither claim was patentable." It is true that Lindberg cancelled claim 15 and moved to insert new claims 18, 19 and 20 as Counts A, B and C. Claim 19 (Count B of the Interference) was considered by the Examiner to be allowable. (Plaintiff's Exhibit 2 — page 74). The claim was not approved for entry in the Lindberg application nor as a Count of the Interference because it was not patentable to Jenkins for the reason that the Lindberg structure had been in public use more than one year prior to Jenkins' filing date. The Examiner stated that "... Count B is not patentable to all parties to the Interference". (Plain-

tiff's Exhibit 2, page 74). Lindberg subsequently inserted claim 24 in his patent application which is a slight revision and broadening of claim 19 (Count B of the Interference) and this claim is claim 1 of the Lindberg Patent. Claim 24 is very similar to claim 15. Lindberg never conceded that the grapple structure recited in claim 15 was not patentable.

B. UTILITY

The utility of the Lindberg two point grapple has been admitted by Defendants-Appellees and acknowledged by the District Court (Transcript of Proceedings, pages 159 and 160):

THE COURT: Do you have anything else, Mr. Berry?

MR. BERRY: Your Honor, I have nothing to say in my closing statement except to point out to the Court that even the Defendants in this case acknowledged the merits of the two point grapple over a three point grapple. You will find in the Jenkins' deposition —

THE COURT: What was that?

MR. BERRY: In the Jenkins' deposition, Your Honor, which is Plaintiff's Exhibit 7, at page 90, Mr. Jenkins acknowledged that the two point grapple had an inherent advantage over a three or four point grapple.

THE COURT: I don't think there is any question about that, is there?

MR. BERRY: This was also confirmed at page 38 of the Hoxie deposition.

THE COURT: What difference would that make?

MR. BERRY: Your Honor, the fact that two point grapples — three and four point grapples

cannot be used as substitutes —

THE COURT: Everybody has been agreeing to that.

MR. BERRY: I wasn't aware of that Your Honor. I have no further remarks.

C. NONOBVIOUSNESS — THE LINDBERG INVENTION WAS NOT OBVIOUS TO ONE HAVING ORDINARY SKILL IN THE GRAPPLE ART AT THE TIME OF THE INVENTION

The Supreme Court has recently stated in *Graham et al. v. John Deere Co. of Kansas City, et al.*, 383 U.S.1, 12, 148 U.S.P.Q. 459, 464-465 and *United States v. Adams et al.*, 383 U.S. 39, 148 U.S.P.Q. 459, that patentability is dependent upon three explicit conditions: novelty and utility as defined in 35 U.S.C. 101, 102 (1964), and nonobviousness, as defined in 35 U.S.C. 103 (1964). Although the obviousness or nonobviousness of the subject matter is a question of law, that legal question must be determined against a factual background, *National Lead Company v. Western Lead Products Company*, 9 Cir., 291 F.2d 447, 450-451. The *Graham* case also particularized the factual inquiries to be pursued in providing a basis for determining the question of obviousness or nonobviousness with the meaning of section 103 as being:

(1) the scope and content of the prior art are to be determined;

(2) difference between the prior art and the claims at issue are to be ascertained; and

(3) the level of ordinary skill in the pertinent art resolved. The Court also stated in the *Graham* case:

“Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy” (383 U.S. at 17-18, 148 U.S.P.Q. at 467)

This Court has had occasion to review and apply these principles in the recent decisions in *Jeddeloh Brothers Sweed Mills, Inc. v. Coe Manufacturing Company*, 9 Cir., 306 F.2d 455, 151 U.S.P.Q. 679, and *Hensely Equipment Co., Inc. v. Esco Corp.*, 9 Cir., 375 F.2d 432, 152 U.S.P.Q. 781. It is thus clear that the obviousness or nonobvious of the Lindberg invention must be decided according to these principles.

The two point grapple structure of the Lindberg Patent is designed for use with log loaders known as “heel boom leaders”. The various steps involved in a heel boom loading operation are illustrated on page 40 of this Brief. Referring briefly to the drawings, the grapple 2 is suspended by cables 3 from a heel boom 4 and a log 5 is engaged short of its mid-point by the grapple 2 as shown in Fig. 1. As the log is lifted it pivots and the short or inner end 5a of the log is forced against a “heeling” plate on the bottom of the heel boom 4, Fig. 2. Upon further lifting of the grapple and log, Fig. 3, the log is caused to pivot again (within the grapple) so as to elevate the long or outer end 5b and is swung to a position above a waiting truck 6. The log is deposited on the truck by lowering the long end 5b to rest on the truck bed (thereby pivoting the log within the grapple for the third time), Fig. 4. The short end 5a of the log is then lowered to the truck bed (pivoting the log within

the grapple for the fourth time) paying out the cables 3, Fig 5.

At the time the Lindberg invention was made, early in 1958, tongs and grapples were generally well known in the logging art. Log loading tongs had been used in heel boom loading for many years, however, there is a serious objection to use of tongs because they rely on opposed points to hold the log. The points of the tongs must penetrate the log thereby often causing serious damage to the log (see Wirkkala Patent No. 2,786,709, Defendants' Exhibit 117). Many loggers preferred to use grapples over tongs because grapples did not depend on penetrating points which damage the log but, rather, employ a lateral squeezing action to grip the logs. Because of this, several logs can be lifted at once and the size of the log which can be lifted may vary from a few inches in diameter to several feet. Another advantage of grapples is that a single operator can perform the job. Tongs on the other hand, have no "squeeze" or "grip" but depend solely upon the digging in of sharp points from which the log "hangs" and tongs must be manually positioned in relationship to the logs, thus requiring at least two men for operation. Tongs are completely inoperative if the log penetrating points are removed.

The problem with grapples which existed at the time of the Lindberg invention was that multiple, spaced jaws were used on at least one side of the grapple to obtain the "balanced" squeeze or grip thought to be necessary to lift a load and to keep it from twisting. When using the three and four jaw grapple for heel boom loading, the log was not free to pivot between the jaws either when the jaws overlapped or when the points of the jaws actually en-

gaged the sides of the large logs. The damage to logs was thus often as great with grapples as with tongs and damage to grapples frequently occurred because of bending stresses resulting from improper alignment of the grapple with the heel boom and operating cables.

As the witness Hoxie (a witness for Defendants-Appellees) testified in part (Hoxie Dep. Pages 34 and 35, Defendants' Exhibit 124).

Q. Mr. Hoxie, will you explain to me what some of the deficiencies are of 3 and 4-point grapples in use in log loading.

A. 3 and 4-legged grapples are all right in deck work or such as that, but to work under a heel boom, why, your 3-point grapple, you are putting an extra strain on your grapple.

Q. On what portion of the grapple?

A. On whichever leg is closest to the boom. That is the one that your leverage is on.

Q. Have you ever seen a 3 or 4-point grapple that was damaged because of this extra strain?

A. I think I have seen grapples in pretty near every shape, manner or form damaged.

Q. Some of the damage at least has resulted from extra strain put on additional points or legs?

A. Because they were not properly designed.

Even with these deficiencies, the grapple provided the advantage of eliminating at least one man in an operation, loading was safer, more rapid and inexpensive.

Because of the basic principle of grapple operation is that of a "lateral squeeze", the concept of grapple structure at the time of the Lindberg invention was

that of a "balanced grip", i.e. the jaws had to be so positioned as not to create a twisting moment on the logs. The balanced grip or balanced force concept is illustrated in the top figure on the drawing on page 41. Thus the lines of force applied by opposing jaws of a multiple jaw grapple were balanced as illustrated by the three point grapples shown in certain of the patents of record in this suit. (Defendants' Exhibits 114 and 123) and the Young three point grapple (Plaintiff's Exhibit 36). The concept of "balanced grip" is still the prevailing concept in three and four point grapples as well as multiple point basket type grapples used in lifting heavy loads where "heeling" is not involved. It is also the prevailing concept in the case of log loading tongs where "heeling" is involved.

The Lindberg concept of grapples for use in heel boom loading of logs was a radical departure from the prevailing concept at the time of the invention. The Lindberg grapple embodies only two jaws which are offset and overlap in a scissors-like action when the grapple is closed, thus providing a "lopsided" or "unbalanced" grip on the log. The offset or overlapping feature permits the jaws to operate with a true grapple action and, in addition, free pivoting of the log between the jaws is permitted and is possible because of the use of *only* two effective points of contact. If the jaws of a two jaw grapple were to be aligned to provide true "balanced grip", the jaws could not overlap and it would be impossible to "squeeze" the smaller logs between the jaws. It was not obvious that a structure with "unbalanced grip" would operate satisfactorily in the handling and loading of logs since the apparent or expected result would be loss of control of the log through canting or twisting of the log because of the turning moment

imposed by the jaws of the grapple on the log and consequent damage to the grapple because of the expected twisting action. The dotted line portion of the bottom figure of the drawing on page 41 illustrates the expected twisting action of the log. This was the general concensus of opinion of experts in the field who expressed disbelief in the invention when the two jaw grapple was first introduced. On this point the Witness Lindberg stated on direct examination by the attorney for Defendants-Appellees. (Lindberg Dep. Pages 12-14, Defendants' Exhibit 143):

Q. When you first had your concept in the beginning of 1958, did you discuss that with anyone?

A. Yes.

Q. With whom?

A. Our sales manager in Oregon.

Q. Who was that?

A. Mr. Eugene Wygant.

Q. Where is he?

A. In Eugene.

Q. Is he still your sales representative? I can't hear you.

A. Yes.

Q. When did you have this discussion with Mr. Wygant?

A. The first part of 1958.

Q. In Eugene or in Salem — I mean in Eugene or Seattle?

A. Over the telephone.

Q. He was in Eugene?

A. Correct.

Q. And what did you explain to him? Give me the substance of your conversation as best you can recall.

A. I can't give it to you exactly, but we had this idea — I had this idea and I explained to him what we should do and how to do it, and we agreed that it would be worth trying.

Q. Well, can you tell me what you told Mr. Wygant?

A. No.

Q. When you say you had this idea, what did you tell him?

A. Basically that a 2-point log grapple would work for heel boom loading.

Q. Had you ever tried it?

A. Not with a grapple, not with a 2-point grapple, no.

Q. — grapple?

A. No, this was when we got the idea of doing it.

Q. Did someone suggest to you previous to that, that this might be a feasible way of heel boom loading?

A. No.

Q. When you suggested this to Mr. Wygant, what did he say?

A. Well, there was some question that it might twist the log — or there were enough unknowns at that time that nobody was sure of this thing.

Q. Did Mr. Wygant indicate that he didn't think it might work?

A. That's what I said, yes.

Q. But you didn't make any models?

A. No.

Q. And I take it you went right into the production?

A. Correct.

Q. But you still had doubts whether it would work?

A. We had — we felt that it would work, but we had not done it before so we had to produce and make one to prove to ourselves that our concept would do the job, which is what we did.

The Supreme Court in the *Adams* case, *supra*, in upholding a combination patent for a wet battery held that the combination was nonobvious because, to conceive the combination required a person reasonably skilled in the art to disregard long accepted principles in the science (art). This reasoning also supports the view that the Lindberg two point grapple was not obvious at the time of the invention since he disregarded the accepted concept or principle of “balanced” grip in grapple loading. The District Court erred in its finding that Lindberg did not disregard accepted principles of mechanics (FINDINGS OF FACT No. 14, R-43) since the evidence shows that, with respect to the grapple art, he did disregard the accepted principles.

The two jaw grapple did operate successfully in heel boom loading and its significance has been recognized. It has become the predominate grapple structure for heel boom loading. On this point the Witness Lindberg stated (Transcript of Proceedings page 57):

Q. Mr. Lindberg, for use in heel boom loading, do you know what the approximate percentage is of the total loading devices that are used in heel boom which comprises two point log grapples?

A. Our own experience in our company is that over

eighty percent of our total grapple sales are two point grapples.

Q. Do you have any knowledge as to whether two point grapples are used for any other purposes other than heel boom loading?

A. They can be. But, they are primarily used for heel boom loading.

Q. Do you know whether it is common today to use three or four point grapples for heel boom loading?

A. It's not common. Three and four point grapples are used for straight crane loading where you want to balance the load.

Also the witness Hoxie testified (Hoxie Dep., Defendants' Exhibit 124, page 36, line 5 to page 37, line 8):

Q. Do I understand your own testimony, then, that the use of a two-point grapple as distinguished from a 3 or 4-point grapple in heel boom logging has very definite advantages?

A. In heel boom logging the 2-point grapples are definitely better than 3 or 4 point.

Q. Mr. Hoxie, I understand that you have recently had an illness. That is correct, isn't it?

A. Yes, that is correct.

Q. Prior to your recent illness how were you employed, at what work?

A. I was logging, cat skinner.

Q. During this most recent employment did you have the occasion to see grapples in use?

A. Yes.

Q. What type of grapples were they? I mean I am

distinguishing between the number of points now.

A. 2 points.

Q. Do you recall in recent years seeing 3 and 4 point grapples in use in heel boom loading?

A. Yes, but not satisfactorily.

Q. Do you recall seeing 3 and 4-point grapples in use for what you termed decking?

A. Yes, they are still in use.

Q. Do the 3 or 4-point grapples have advantages over the 2-point in a decking operation?

A. Not necessarily. Mostly it is the price.

Q. The 3 and 4-point are more expensive, are they?

A. The 3 and 4-point are cheaper. They can pick them up on the second-hand market for pennies.

The commercial success and wide acceptance of the Lindberg two point grapple is also demonstrated by fact that two principle manufactures, Dommion Bridge Co., Ltd. and Albin Manufacturing Co., Inc. took licenses from Plaintiff, Young Corporation, (Plaintiff's Exhibit 32 and 33).

The many known advantages of grapple loading plus the added advantages of easily grabbing and pivoting of large and small logs were thus made available in heel boom loading without the attendant disadvantages which had existed in the prior art. The Lindberg two jaw grapple utilizing "unbalanced grip" constitutes an improved operable structure which eliminates the disadvantages of both tongs and prior art grapples and yet combines the advantages of both.

The very history of the use of tongs for heel boom log loading, experiments with hooks and the like and finally the almost complete shift to the use of grapples illustrates a long search by the industry for an acceptable, safe and efficient means for heeling logs. This search did not end until Lindberg made the final contribution. The elimination of waste by elimination of damage to valuable logs as well as to grapple structure, the wide acceptance of the two jaw grapple by the industry; these factors, although not in themselves controlling, are indicia of actual invention and are properly considered, *Graham* case supra, and *National Sponge Cushion Co. v. Rubber Corp.*, 286 F.2d 731, at page 735, 128 USPQ 320 (CA9-1961).

Defendants-Appellees claim that the Lindberg invention was a limited improvement in a crowded art. Although Defendants listed some twenty-three patents as representative of the prior art, (Defendants' Answer, R-10 and 11, Pre Trial Order, R-33) it is to be noted that the patents include not only grapples but also tongs, hooks and even buckets. The art cited covers a period of almost ninety years. This alone does not establish or even suggest that the art pertaining to log loading grapples or grapples in general is crowded or that Lindberg's invention was insignificant. None of the patents cited, including the patent to Hunt relied upon as the sole anticipating reference, teach the use of an "unbalanced grip" in heavy lifting devices as does the Lindberg two jaw grapple with overlapping jaws. It is clear from inspection that the Hunt patent teaches a balanced grip, multiple jaw grapple for use in dredging and the only expert testimony on the patent supports that conclusion (Transcript 112 and 113).

The basic question then is not merely whether the art is "crowded" or how many patents are classified in a given art but whether or not the invention embodies significant and substantial advantages or improvements in the art. This can be measured by indicia such as commercial success, wide spread acceptance in the industry and copying by others. Defendants-Appellees take the position that the improvement was a limited one in a crowded art. The wide acceptance of the two jaw grapple and Defendant's own adoption and preference for the structure, however, belies this position.

FIG. 1

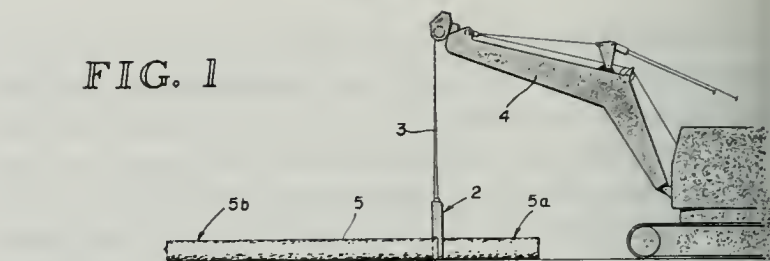


FIG. 2

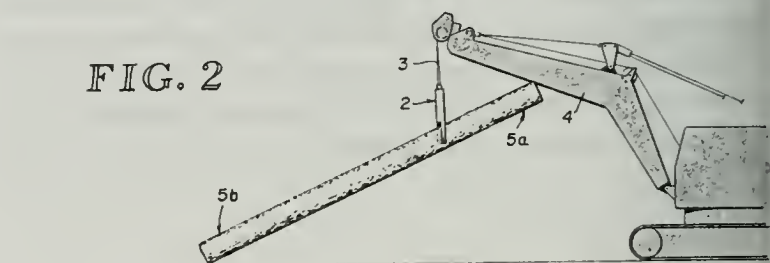


FIG. 3

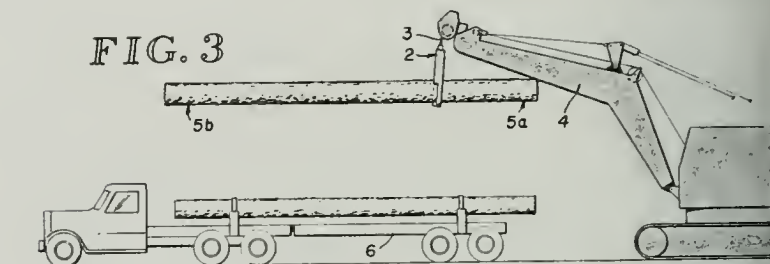


FIG. 4

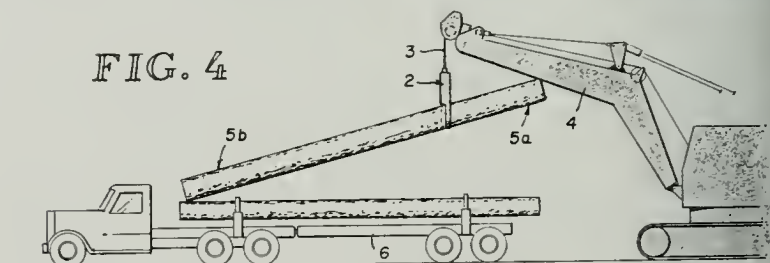
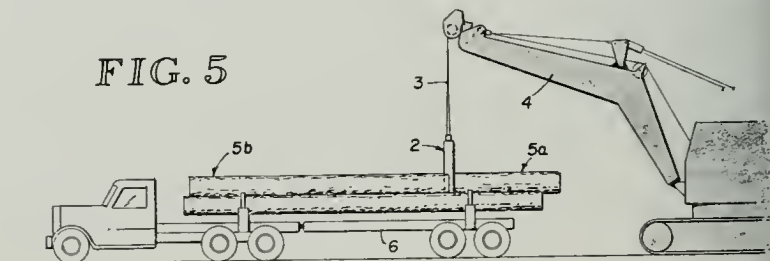
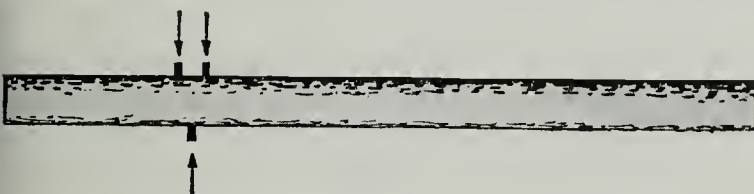
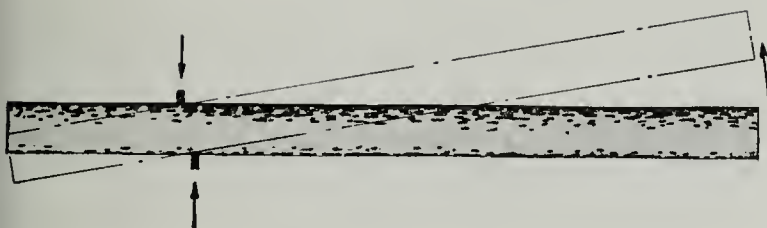


FIG. 5





D. DEFENDANTS-APPELLEES HAVE FAILED TO OVERCOME THE PRESUMPTION OF VALIDITY THAT ATTACHES TO THE LINDBERG PATENT AND TO SUPPORT THE BURDEN OF PROVING INVALIDITY

Defendants-Appelless rely on one patent, the Hunt patent, as being the only pertinent reference against claim 1 of the patent in suit. Lindberg testified in detail at trial, as an expert witness, to the effect that the Hunt patent does not show a two point or two jaw grapple. The Hunt patent is thus no more pertinent than the prior art considered by the Patent Examiner. Defendants-Appellees offered no evidence to refute or discredit this expert testimony nor was any evidence offered in the way of expert testimony concerning any of the prior art references that were before the District Court and Patent Examiners. Only argument of counsel was offered on the point of content and scope of the prior art patents. Argument of Counsel is not entitled to evidentiary weight.

On the question of obviousness under 35 U.S.C. 103, Plaintiff-Appellant introduced the Deposition of the party Lindberg to the effect that at least one other person, Mr. Eugene Wygant, a sales and field representative of Young Corporation and one skilled in the grapple art, did not think the two point grapple concept was the obvious approach or answer to the problems experienced in the use of grapples. No testimony nor evidence to the contrary was offered to disprove this fact.

Likewise there is no evidence to counter the fact that the party Jenkins himself copied the claim language describing a two point grapple. Mr. Jenkins is undoubtedly an expert in the grapple art and it did not

appear obvious to him at the time of the invention or he would not have tried to make the claim.

There is nothing to disprove that at least three Examiners in the Patent Office, all experts in the art, did not consider the invention unobvious since they approved and issued the Lindberg Patent. Reference is made to the Examiner's opinion on patentability of the Lindberg claim as clear proof of his position (Plaintiff's Exhibit 6, pages 41-52). The Examiner who wrote the opinion noted was the same Examiner who handled the application during Ex Parte prosecution.

In the final analysis the real question is whether or not the invention was obvious to one skilled in the pertinent art. The evidence shows that it was not obvious to Lindberg, Jenkins, Mr. Wygant, and three Patent Examiners. Defendants-Appellees must overcome this clear evidence with something more than argument in order to overcome the presumption of validity and to meet the burden of proving invalidity.

Respectfully submitted,

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CERTIFICATE OF SERVICE

A true copy of the within Appellant's Opening Brief has been sent to J. Pierre Kolisch, Kolisch and Hartwell, 1004 Standard Plaza, Portland, Oregon 97204, as attorney for Appelles' by United States mail this 5th day of September, 1967.

BENJAMIN F. BERRY

Counsel for Plaintiff-Appellant

CERTIFICATE OF COMPLIANCE

I certify that, in connection with the preparation of this Brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing Brief is in full compliance with those rules.

BENJAMIN F. BERRY

Counsel for Plaintiff-Appellant

Appendices

APPENDIX

35 U.S.C. 101 Inventions Patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 102. Conditions for Patentability; Novelty and Loss of Right to Patent

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country; or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * *

35 U.S.C. 103. Conditions for Patentability, Non-obvious Subject Matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

